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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/591,270	06/09/2000	Kenneth Shepard	AP32158-070050.1280	2448

21003 7590 02/24/2004

BAKER & BOTTS  
30 ROCKEFELLER PLAZA  
NEW YORK, NY 10112

EXAMINER
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SHARON, AYAL I

ART UNIT	PAPER NUMBER
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2123

DATE MAILED: 02/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**REQUIREMENT FOR INFORMATION – 37 C.F.R. § 1.105**

1. The Evidence in the Declaration submitted by the Applicant (paper #5, filed 12/08/2003) raises issues of inventorship and priority.
  - a. Exhibit A in the Declaration is an article with the title "Probabilistic Determination of the Body Voltage in Digital PD-SOI circuits and Its Application to Static Timing Analysis". It does not have any listed authors, yet begins with the sentence "We describe a technique ...". Clearly there is more than one author, and therefore constitutes a different inventive entity than the instant application, which lists only Dr. Shepard as an inventor.
  - b. Exhibit A lacks a publication date. Examiner performed a search on the title, and was unable to find any published article with the same title.
  - c. Exhibit A is an identical copy of the article submitted in the provisional application 60/138,842.
  - d. In regards to Exhibit A, paragraph 3 of the Declaration states that "prior to the critical date, I made an original submission of the inventions to the International Conference on Computer Aided Design (ICCAD) on April 9, 1999." However, the only paper presented by the Applicant at the ICCAD 1999 conference was co-authored with Dae-Jin Kim. (see p.7 of "ICCAD 1999: San Jose, California, USA"). This article, previously cited by the Examiner in an IDS, is titled: "Body-Voltage Estimation in Digital PD-SOI Circuits and its Application to Static Timing Analysis".

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- e. Exhibit B is a slide presentation titled: "Bounding Uncertainty in the Static Timing Analysis of Digital PD-SOI Circuits." It has two authors: Dae-Jin Kim and Ken Shepard. This is a different inventive entity than in the instant application.
2. Examiner has located another article co-authored by the Applicant and Dae-Jin Kim, titled "Static Noise Analysis for Digital Integrated Circuits in Partially-Depleted Silicon-On-Insulator Technology", dated June 2000.
- a. This article states that "This work was supported in part by the National Science Foundation under grant CCR-97-34216 and by a grant from the IBM Corporation."
  - b. The article shares a figure with the document in the provisional application 60/138,842 and Exhibit A of paper #5.
  - c. The instant application also cites the same NSF grant CCR-97-34216.
  - d. However, the instant application makes no mention of the IBM grant.
  - e. The art cited in the 102(e) rejection is a PG-PUB of a U.S. Patent Application assigned to the IBM corporation.
3. **Applicant and the assignee of this application are required under 37 CFR 1.105 to provide the following information that the examiner has determined is reasonably necessary to the examination of this application:**
- a. Applicant is required to provide a list of authors for Exhibit A of the declaration (paper #5).

- b. Applicant is required to provide a publication date for the Exhibit A of the declaration (paper #5).
- c. Applicant is required to provide evidence for the priority date of Exhibit A that is cited in the declaration (paper #5)
- d. Applicant is required to provide information on the relationship between Exhibit A and the article that was publicly presented at the ICCAD 1999 conference by the Applicant and Dae-Jin Kim ("Body-Voltage Estimation in Digital PD-SOI Circuits and its Application to Static Timing Analysis").
- e. Applicant is required to provide a clarification regarding inventorship because the following all have inventive entities than differ from that of the instant application:
  - i) Exhibit A, (which states: "We describe...", but does not list the multiple authors).
  - ii) Exhibit B.
  - iii) The article publicly presented at ICCAD 1999.
- f. Applicant is required to provide documentation pertaining to the IBM grant cited in the "Static Noise Analysis for Digital Integrated Circuits in Partially-Depleted Silicon-On-Insulator Technology" article, including documents submitted for the proposal and documentation detailing the purpose of the grant.

- g. Applicant is required to state if IBM has rights to the inventions in this application. (Applicant has already stated in the Specification that the U.S. Government has rights to the inventions in this application.)

4. **The fee and certification requirements of 37 CFR 1.97 are waived for those documents submitted in reply to this requirement.** This waiver extends only to those documents within the scope of this requirement under 37 CFR 1.105 that are included in the applicant's first complete communication responding to this requirement. Any supplemental replies subsequent to the first communication responding to this requirement and any information disclosures beyond the scope of this requirement under 37 CFR 1.105 are subject to the fee and certification requirements of 37 CFR 1.97.
5. **The applicant is reminded that the reply to this requirement must be made with candor and good faith under 37 CFR 1.56.** Where the applicant does not have or cannot readily obtain an item of required information, a statement that the item is unknown or cannot be readily obtained will be accepted as a complete reply to the requirement for that item.
6. This requirement is subject to the provisions of 37 CFR 1.134, 1.135 and 1.136 and has a shortened statutory period of 2 months. EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).
7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ayal I. Sharon whose telephone number is

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(703) 306-0297. The examiner can normally be reached on Monday through Thursday, and the first Friday of a biweek, 8:30 am – 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Teska can be reached on (703) 305-9704. Any response to this office action should be mailed to:

Director of Patents and Trademarks  
Washington, DC 20231

Hand-delivered responses should be brought to the following office:

4<sup>th</sup> floor receptionist's office  
Crystal Park 2  
2121 Crystal Drive  
Arlington, VA

The fax phone number for the organization where this application or proceeding is assigned is:

(703) 872-9306.

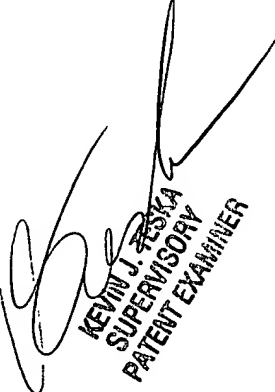
Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist, whose telephone number is:

(703) 305-3900.

Ayal I. Sharon

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February 23, 2004

  
KEVIN J. TESKA  
SUPERVISORY  
PATENT EXAMINER